



Docket: 0792-0119

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re Patent Application of
Vernon R. ROTCHSCHILD**

Serial No.: 08/753,929

Filed: December 3, 1996

For: NATURAL FOOT ORTHOSIS AND
METHOD OF MANUFACTURING THE
SAME

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C.

Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith is a Request for Reconsideration in the above-identified application.

No additional fee is required.

[X] In the event applicant(s) has overlooked the need for any petition and fee for extension of time, and such extension is required, applicant(s) requests that this be considered a petition therefor and that such fee be charged to Deposit Account No. 19-2380.

[X] The Commissioner is hereby authorized to charge fees under 37 CFR 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c) and 1.20 (d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment, to Deposit Account No. 19-2380. A duplicate copy of this sheet is attached.

Respectfully submitted,



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For: NATURAL FOOT ORTHOSIS AND
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SAME) Art Unit:3764
) Examiner: J. Clark
)
)**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on 7-14-99.

Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated April 14, 1999, Applicants respectfully request that the rejection of claims 1, 13, 15 and 27 be reconsidered and withdrawn by the Examiner for the following reasons.

Initially, Applicants wish to acknowledge the Examiner's indication on page 3 of the Office Action that claims 2, 3, 4, 5, 9, 10, 14, 17, 18 and 24 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claims and any intervening claims.

With reference now to page 2 of the Office Action, claims 1, 13, 15 and 27 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,938,777 issued to Mason et al. in view of U.S. Patent No. 5,022,390 issued to Whiteside. This rejection is respectfully traversed in that neither the patent to Mason et al. nor that of Whiteside when

taken alone or in combination disclose or remotely suggest that which is presently set forth by Applicants' claimed invention.

Initially, Applicants question the rejection of Applicants' claimed invention under 35 U.S.C. §102(b) as being anticipated by a base reference when taken in view of a secondary reference. Clearly, Applicants' claimed invention cannot be anticipated by a combination of references. Accordingly, the following comments will be directed to the rejection of claims 1, 13, 15, and 27 as though they were rejected under 35 U.S.C. §103 as being unpatentable over Mason et al. in view of Whiteside. Should this understanding of the rejection be incorrect, the Examiner is respectfully requested to clarify such rejection in a subsequent Office Action and clearly such clarification should not be made final.

In rejecting Applicants' claimed invention, the Examiner states that Mason et al. discloses the claimed invention except for the specific steps of forming a positive mold and vacuuming sealing as claimed. In view of such shortcomings, the Examiner relies on the teachings of Whiteside stating that it is well known in the art to form a positive mold of a lower extremity, wrapping a multiple of thermoformable plastic material about the mold and vacuuming sealing materials and the molds so that the materials are "bond" together citing column 2, lines 35-49. This characterization of the references by the Examiner is clearly erroneous for the following reasons.

The citation noted by the Examiner in Whiteside recites that:

"Fabricating members 12 and 13 first requires that casts be made
of the wearers limb and from these casts male molds are made

in configuration of the limbs. Warm sheets of plastic are draped over the male molds and a vacuum applied there beneath to pull the sheets over and into intimate contact with the molds. After being cooled, the members 12 and 13 are trimmed to the desired peripheral configurations."

While the Examiner is of the position that this portion of the reference discloses that a plurality of thermoplastic sheets are vacuumed formed about the molds in order to "bond" together, it is respectfully submitted that this recitation does not support such a conclusion. It is clear that this portion of the reference discusses two separate molds one being the male mold for forming the upper portion 13 of the orthotic device and the second mold being the male mold for forming the lower portion 12 of the orthotic device. There is no discussion that the plurality of thermoplastic sheets are applied over the same mold such that two distinct thermoformable plastic members are bonded together. Furthermore, the term bonded or any similar term is nowhere found in this passage. As is clearly illustrated in Fig. 2 of the Whiteside reference, the cross sectional view illustrates only a single sheet forming the lower portion of the orthotic device 12 and a single sheet forming the upper portion of the orthotic device 13. There is clearly no discussion or suggestion of forming either the upper or lower portion of the orthotic device of Whiteside from multiple thermoplastic sheets, as suggested by the Examiner. Although the recitation referred to by the Examiner recites sheets of plastic, this clearly refers to one single sheet for fabricating the lower member 12 and one of the single sheet for fabricating the upper member 13.

Accordingly, it is respectfully submitted that Applicants' claimed invention as set forth in independent claims 1 and 15 clearly distinguish over the combination proposed by the Examiner. Accordingly, it is respectfully submitted that Applicants' claimed invention as set forth in independent claims 1 and 15 as well as those claims which depend therefrom clearly distinguishes over the prior art of record. Moreover, in that independent claims 1 and 15 are generic to all species set forth by Applicants' claimed invention, it is respectfully requested that the non-elected claims be included in the allowance of claims 1-5, 9, 10, 13, 14, 15, 17, 18, 24 and 27.

Should the Examiner believe a further conference would be of benefit in expediting the prosecution of the instant application, she is hereby invited to telephone council to arrange such a conference.

Respectfully submitted,



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